

REMARKS

In response to the Office Action dated 21 April 2004, Applicants request reconsideration and withdrawal of the rejections set forth in the Office Action in view of the above amendments and the following remarks.

Claims 1, 2, and 12 were rejected under 35 U.S.C. §103 (a) as being “unpatentable over Yanagi (U.S. Patent No. 6,118,528) in view of Kirschen. (U.S. Patent No. 4,035,082.)” To properly maintain a rejection under 35 U.S.C. §103, the prior art must have suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process, with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in the applicant's disclosure. See *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Moreover, “[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention...” M.P.E.P. §2141.

Yanagi is unacceptable as a primary reference because Yanagi is different from the present invention. In Yanagi's lens meter, a light source is to provide a measuring light having at least three different wavelengths, whereas, in the present invention, a monochromatic light source is used to provide a monochromatic illuminating light having one predetermined wavelength. Furthermore, Yanagi does not disclose nor suggest that using an illuminating light having several wavelengths would cause deterioration in the quality of the produced image of a lens to be inspected for defects. Yanagi does not disclose nor suggest anything about how to minimize the deterioration of the image quality associated with an illuminating light having more than two different wavelengths, and anything about using of a monochromatic illuminating light having one predetermined wavelength in reproducing the image of a contact lens with increased resolution. Applicants respectfully submit that Yanagi does not teach or provide a motivation to arrive at the present invention. As is well established, the motivation to modify the prior art must flow from some teachings in the art that suggest the desirability or incentive to make the modification needed to arrive at the claimed invention.

Kirschen discloses “a device to test for the presence of chemically hardened glass.” ‘082 Patent, Abstract. Applicants have amended claim 1 to include contact lenses, which are not made of glass. Kirschen does not disclose a monochromatic light source for inspecting a contact lens, so that any defect on the lens can be accurately determined in a more efficient manner.

Kirschen discloses a method used to detect whether glass has been chemically hardened, not whether it has defects such as cavities, tears, inclusions, contamination leakages from the edge or the like. See, U.S. Application No. 09/920,690, page 3. Applicants respectfully submit that with the above amendment to claim 1, the 103(a) rejection has been overcome and claims 1-22 are in condition for allowance. Applicants respectfully request reconsideration.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Karen Borrelli, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



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